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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter Styczynski et al.

Art Unit : 1617

Serial No. : 09/893,252

Examiner : Lauren Q. Wells

Filed : June 27, 2001

Title : REDUCTION OF HAIR GROWTH

**Mail Stop Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO ACTION OF MAY 19, 2004

Applicants discovered that hair growth can be reduced by inhibiting the enzyme telomerase. Claim 1 is directed to that discovery and requires topical application, at least once a day over at least two days, of a composition including an inhibitor of telomerase. The inhibitor penetrates the skin, into the hair follicle, and inhibits telomerase, causing a reduction in hair growth.

Applicants' discovery is an example of reducing hair growth by topical application of compositions including a compound that interferes with the biological mechanism of hair growth. Styczynski et al., U.S. Pat. 6,020,006 ("Styczynski") is another example. Styczynski is directed to reducing hair growth by topical application of a composition including an inhibitor of the enzyme alkaline phosphatase.

Reducing hair growth by interfering with the biological mechanism of hair growth is fundamentally different from removing unwanted hair through use of depilatories, which are agents or compositions that dissolve or destroy hair. Nair® is an example of a known depilatory composition; there are many others. Depilatories do not gradually reduce the growth of hair by interfering, biologically, with hair growth, but rather remove the hair entirely. Depilatories are

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October 19, 2004

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not commonly used on a daily basis because there is no need to; it takes time for hair, once removed, to regrow.

Claim 1, the only pending independent claim, has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Styczynski in view of Black, WO 99/19466 ("Black"). Black teaches that AZT can be used as a depilatory agent that destroys hair follicles. The Examiner contends that it would have been obvious to combine the AZT of Black with the composition of Styczynski and to use the resulting composition according to the regimen disclosed by Styczynski.

Applicants respectfully request that the rejection be reconsidered and withdrawn. Styczynski and Black teach two fundamentally different approaches for dealing with unwanted hair. As discussed previously, Styczynski describes a composition including a compound (the inhibitor of alkaline phosphatase) that interferes with the biological mechanism of hair growth. Over time, after repeated application of the composition, hair growth is reduced because the hair stops growing as quickly. In contrast, Black teaches using AZT to destroy hair, not to interfere with the biological mechanism of hair growth.

A person of ordinary skill in the art generally would not be motivated to combine the AZT from Black with the composition in Styczynski because depilatory compositions work differently from compositions that interfere with the biological mechanism of hair growth. Moreover, that person would not be motivated to apply AZT according to the regimen disclosed by Styczynski (at least once a day for at least two days) because, according to Black, AZT is a depilatory agent and thus would destroy the hair in one application.

The combination of Styczynski and Black is a pure hindsight combination that does not make technical sense. The Examiner is reminded that the Court of Appeals for the Federal Circuit repeatedly has cautioned against using the claimed invention as a roadmap for constructing an obviousness rejection. For example, in W.L. Gore & Associates v. Garlock, Inc., 220, U.S.P.Q. 303, 312-13 (1983):

To imbue one of ordinary skill in the art with knowledge of the invention...when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

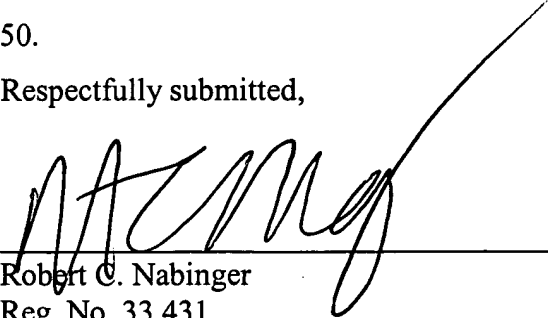
Applicant : Peter Styczynski et al.  
Serial No. : 09/893,252  
Filed : June 27, 2001  
Page : 3 of 3

Attorney's Docket No.: 00216-552001/H-245 (Kay 32)

Enclosed is a \$430.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: October 19, 2004



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